

Patent
Attorney Docket No.: AUS920010309US1
(IBM-0012)

REMARKS

Applicant thanks the examiner for his thoughtful consideration of this case.

Claims 3-5, 13-15, 36, 37 and 44 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner draws attention to the term "gradually" as not being defined by the claims and asserts that the specification does not provide a standard for ascertaining the requisite degree such that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Applicant asserts that a *prima facie* case of indefiniteness has not been established. Specifically, the rejection does not establish that the limitation of the claim, interpreted in light of the specification by one of ordinary skill in the art, does not reasonably define the invention. The MPEP, Section 2173.02 says:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.

The fact that claim language includes words of degree, or relative terms that may not be precise, does not automatically render the claim indefinite under Section 112, second paragraph. Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

Applicant asserts that the term "gradually" is used in accordance with its ordinary meaning and that the specification is not required to provide an express definition. The term "gradually" means "proceeding by steps or degrees." (<http://www.m-w.com/dictionary/gradually>, on March 16,

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2006). When something occurs “gradually” over time, it does not stay the same and it does not complete its change in a single moment.

Furthermore, the specification provides a sufficient disclosure that one of ordinary skill in the art would understand what is being claimed. The specification states that, in accordance with the invention, “online subscription providers can maintain contact with subscribers who have failed to renew subscriptions after subscriptions have expired . . .” (Specification, page 2, lines 25-28). This contact is maintained by “permitting access to the online subscription content but at gradually reduced levels of service.” (Specification, page 2, lines 28-30). Online subscribers are provided with “access to the subscription content at a normal level of service during the subscription period but after the subscription has expired, the online subscription provider may reduce, but not terminate, the level of service during a post-expiration period.” (Specification, page 3, lines 1-4). The level of service may be reduced according to the conditional subscription policy which may include “decreasing the content available to a subscriber, downloading the subscription content at a slower than normal rate, delivering certain features in black and white instead of color, deleting sound files that are delivered in the full level of service subscription, disabling any inter-active features, . . . , or any combination of these features.” (Specification, page 3, lines 8-15). “The level of service may be reduced incrementally based upon one or more factors such as time, access attempts, server availability and subscriber rating. (Specification, page 3, lines 16-17).

Accordingly, Applicant asserts that one having ordinary skill in the art would understand what is being claimed by the claim limitation of “gradually reducing the level of service during the post-expiration period” when read in light of the specification. For example, this may include decreasing the content available to a subscriber or slowing the download rate (Specification, page 3, lines 8-15) based on time or access attempts (Specification, page 3, lines 16-17). One having ordinary skill in the art would understand the scope of what is being claimed. Reconsideration and withdrawal of the rejection is requested.

Claims 1, 3, 4, 33 and 48 stand rejected under 35 U.S.C. 102(e) as being anticipated by Drosset et al. (U.S. 6,662,231). Applicant has amended independent claim 1 to include, among other things, the step of “terminating subscriber access to the online subscription service after the post-expiration period unless the subscription is renewed.” This amendment encompasses the limitations

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of claim 10. Independent claims 33 and 48 have been amended to include, among other things, the limitation of "terminating instructions for terminating subscriber access to the online subscription service after the post-expiration period unless the subscription is renewed." This amendment encompasses the limitations of claim 41. Since claims containing the foregoing limitations were not rejected on the basis of anticipation and the examiner has stated that "Drosset did not explicitly state terminating subscriber access to the online subscription service after a specified post expiration period", Applicant requests reconsideration and withdrawal of the rejection.

Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Drosset. Claim 10 had been cancelled. However, the limitations of claim 10 have been incorporated into independent claim 1, so Applicant would like to briefly address the rejection as it might now pertain to claim 1.

Claim 1 has been amended to include the additional limitations of claim 10 as well as other changes. Specifically, claim 1 now includes, *inter alia*, the steps of "(b) after expiration of the subscription period, providing the subscriber with access to the online subscription service at a level of service that is lower than the first level of service *during a post-expiration period; and then (c) terminating subscriber access to the online subscription service after the post-expiration period unless the subscription is renewed.*" Whereas step (c) includes the limitations of claim 10, the highlighted phrases emphasize the other changes made to the claim. The limitation of providing a reduced level of service "during a post-expiration period" is found in the specification at page 3, lines 3-4. The limitation of terminating access "unless the subscription is renewed" is found in the specification at page 3, line 21 and page 7, lines 21-22. Furthermore support for these limitations can be found through consideration of the specification in its entirety. Together, these two steps are not taught or suggested by Drosset alone or in combination with the Official Notice detailed by the examiner.

Drosset teaches a system in which "there may be two membership levels, paying and non-paying." (Drosset, col. 19, lines 49-51). "[A] user may downgrade from paying to non-paying membership through user selection or through invalidation of the payment information . . ." in which case "the [nonpaying] user is denied the privileges afforded to paying user." (Drosset, col. 15, lines 48-53). Drosset provides privileges to paying members and denies the privileges to non-paying

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members. This is underscored by Drosset using a "Subscribed Boolean value that indicates that the user is subscribed to the service." (Drosset, col. 3, line 65). Accordingly, Drosset does not teach, show or suggest the steps of "(b) after expiration of the subscription period, providing the subscriber with access to the online subscription service at a level of service that is lower than the first level of service *during a post-expiration period; and then* (c) terminating subscriber access to the online subscription service after the post-expiration period *unless the subscription is renewed*."

The Examiner asserts that Drosset teaches "[t]he account is not terminated, but rather just downgraded until the customer has made payment." (Office Action, page 3, line 2). Claim 1 includes both providing a lower level of service during a post-expiration period and then terminating subscriber access after the post-expiration period unless the subscription is renewed. Reconsideration and withdrawal of the rejection is requested.

Furthermore, Applicant asserts that Drosset's disclosure of downgrading access on expiration due to nonpayment teaches away from terminating access after expiration, as set out in the examiner's Official Notice. There is no motivation or suggestion to combine these teachings or modify the reference as suggested.

Claims 11, 13-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Drosset in view of Nye (U.S. 2003/0028548). Claims 11-15 all depend (directly or indirectly) from claim 1, which has been amended to include the limitations of claim 10. Since the present rejection has not been asserted against claim 10, Applicant believes that the rejection is no longer proper.

Claims 21, 29 and 46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Drosset in view of Davis et al. (U.S. Pub. 2002/0040395). Claim 21 ultimately depends from independent method claim 1, claim 29 is an independent system claim, and claim 46 ultimately depends from independent computer program product claim 33. These independent claims have been distinguished from Drosset as pointed out above. While Davis is cited as disclosing a limitation of the claims 21, 29 and 46, Applicant asserts that Davis does not provide disclosure that would teach, show or suggest the limitations of the independent claims. Reconsideration and withdrawal of the rejection is requested.

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Claims 16-20, 23, 24-28, 30-32, 34-45 and 47 include limitations substantially similar to the limitation of claims 1-15, 21, 22, 29, 33, 46 and 48, and are therefore rejected under the same rationale as being substantially similar. Applicant is unfamiliar with a rejection of this manner and believe that a full statement of the basis for each and every rejection is required. However, Applicant also believes that the foregoing remarks and amendments are equally applicable to the claims mentioned here. Therefore, Applicant reasserts the remarks and amendment made above and requests reconsideration and withdrawal of the rejection.

In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/IBM-0012 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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